

## **Remarks**

### ***Status of Claims***

This paper is submitted in response to the non-final Office action mailed June 16, 2005. Claims 1, 5-13, 27, 29-31, 33, and 36-51 stand rejected and claims 32, and 34-35 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Objections***

The Office action objects to claim 38 based on the following informality: “unrelated term cited in the claim.” In response, claim 38 is currently amended to remove the text, “Page 10, line 18”, which was inadvertently placed in the claim. Accordingly, Applicant respectfully requests withdrawal of this objection.

### ***Claim Rejections – 35 U.S.C. §102(e)***

#### **Claims 1, 5-9, and 11-13**

The Office action rejects claims 1, 5-9, and 11-13 as allegedly being anticipated by U.S. Patent No. 6,681,121 (Preston) under 35 U.S.C. § 102(e). In particular, it alleges that “column 2, lines 41-column 4, line 7 and figure 2” of Preston anticipates the “providing a mobile unit . . . operable to communicate in a plurality of alternate modes of digital wireless communication, including at least one packet data mode and a voice mode for establishing a call over a voice channel” element of claim 1. However, Preston does not disclose “a mobile unit . . . operable to communicate in . . . at least one packet data mode.” In fact, Preston indicates that “[t]he IBS modem 28 enables voice signals 22 and digital data 29 to be transmitted over the same digital audio channel using the same cell phone circuitry.” Preston, column 3, lines 17-19. Therefore, Preston discloses sending digital data over an “audio channel,” not also over a “packet data mode” as required by claim 1.

The Office action also alleges that “digital or voice” of Preston anticipates the “operating the mobile unit to assess at least a selected characteristic of each of the alternative modes” element of claim 1. Applicant respectfully asserts that this allegation is ambiguous<sup>1,2</sup> and maintains that Preston fails to anticipate claim 1.

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<sup>1</sup> The patent rules indicate that in rejecting claims for want of novelty the examiner must cite the best references at his or her command. When a reference is complex or shows

Next, the Office action alleges that “search” of Preston anticipates the “based on the assessment” element of claim 1, and that “column 7, 23-50” of Preston anticipates the “determining a preferred mode” element of claim 1. Preston is describing how the “IBS decoder . . . searches for tones in the audio signal that represent digital data.” Preston explains that “[t]he IBS decoder 98 repeatedly samples and decodes the audio signals received from the audio channel 34.” If the “Signal to Noise Ratio (SNR), for tones within the frequency range of the digital data tones, are greater than a preselected value, the IBS decoder 98 goes into an active state 112” and the IBS decoder begins collecting tone samples. If it identifies the preamble of the IBS packet, after a few steps, it demodulates the packet payload. The cited portion of Preston does not disclose “determining a preferred mode” based on an assessment of “at least a selected characteristic of each of each of the alternative modes,”<sup>3,4</sup> and therefore does not anticipate the quoted portion of claim 1.

Finally, the Office action alleges that “column 9, lines 35-45 and figure 14” of Preston anticipates the claim limitation “if the preferred mode is the voice mode, transmitting data via the voice mode without significantly interrupting human speech communications over the same voice channel call” element of claim 1. Preston is disclosing that “[a]fter the audio channel is established . . . the user 23 pushes button 206 [which connects the IBS modem to audio channel].” It continues to explain that “[a]fter the data has been successfully transmitted, the user presses button 206 again [which] reconnect[s] switch 204 to the audio receiver 17.” Therefore, during the period defined by (1) the user pushing the button to connect the IBS modem to the voice channel (thereby facilitating data transmission) and (2) the user pushing the button to reconnect the audio receiver to the voice channel, the user will not be able to communicate human speech over the voice channel. This is not the same as “transmitting a first digital data set from the mobile unit via the voice mode without significantly interrupting human speech communications over the same voice channel call.” (quoting claim 1).

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or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. 37 C.F.R. §1.104.

<sup>2</sup> The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. MPEP §706.

<sup>3</sup> Referring to the “alternative modes of digital wireless communication, including at least one packet data mode and a voice mode for establishing a call over a voice channel.”

<sup>4</sup> Quoting claim 1.

For at least these reasons, claim 1 is patentable over Preston. Because claims 5-9, and 11-13 incorporate each of claim 1's respective limitations they are patentable over Preston for at least the reasons discussed *supra*. Accordingly, Applicant respectfully traverses and requests reconsideration and withdrawal of the rejection.

#### Claims 27 and 30

The Office action also rejects claims 27 and 30 as allegedly being anticipated by Preston under 35 U.S.C. § 102(e). In particular, it alleges that "column 2, line 54 – column 3, line 5" of Preston anticipates the limitation "wherein the call center is operable to receive location information from the remote unit and to process the location information to generate location information in a second format; and the call center is further operable to transmit the second format information back to the remote unit" element of claim 27. At this point, Preston discloses connecting the cell phone call to: (1) another cell phone in the wireless network, (2) a landline phone on a PSTN network, or (3) a phone reachable via a Voice Over IP network. It also indicates that the cell phone call "can also be routed from the PSTN network 42 back to the cellular network 12 or from the PSTN network 42 to the IP network 46, or visa versa." Preston, column 3, lines 1-3. "The cell call eventually reaches a telephone 44 that corresponds with a destination phone number originally entered at the cell phone 14." *Id.* at lines 3-5. Nowhere does Preston discuss a call center that is operable "to process the first data set to generate a second data set comprising location information," (quoting claim 27) nor does Preston disclose a call center being "further operable to transmit the second data set to the remote unit." (quoting claim 27).

Furthermore, Preston does not disclose a call center "being operable to communicate with a remote unit via a plurality of modes selected from the group of modes including voice and data calls via the wireless telecommunication network." (quoting claim 27). For at least these reasons, claim 27 is patentable over Preston. Because claim 30 incorporates each of claim 27's respective limitations it is patentable over Preston for at least the reasons discussed *supra*. Accordingly, Applicant respectfully traverses and requests reconsideration and withdrawal of the rejection.

#### Claim 31

The Office action also rejects claim 31 as allegedly being anticipated by Preston under 35 U.S.C. § 102(e). In particular it alleges that "column 9, line[s] 10-54 and figure 14-15" anticipates every element of claim 31 and explains "Preston switches from voice to data

mode then preston [sic] mutes the voice mode and transmit [sic] data.” However, Preston does not disclose “determining whether a voice mode is a primary transmission mode for location data transmission.” (quoting claim 31). In addition, Preston does not disclose “determining whether a call is currently active,” (quoting claim 31) nor does it disclose “if no call is currently active, establishing a voice mode call over a voice channel to a predetermined call center.” (quoting claim 31). In fact, Preston indicates that “[t]he user 23 can push the button 206 anytime after manually calling up a phone number.” Preston, column 9, lines 35-36. For at least these reasons, claim 31 is patentable over Preston. Accordingly, Applicant respectfully traverses and requests reconsideration and withdrawal of the rejection.

#### Claims 44-46

The Examiner rejected claims 44-46 as allegedly anticipated by Preston under 35 U.S.C. § 102(e). In particular, it alleges that “column [sic] and figure 1,” “column 2, line 54-column 3, line 5,” and the “abstract” of Preston anticipate claim 44. Claim 44, among other elements, requires “automatically muting any voice communication on the call; transmitting the converted location data in the voice channel to the call center; and automatically un-muting the voice communication on the call.”

Preston, on the other hand, indicates that “[t]he user 23 can push the button 206 anytime after manually calling up a phone number.” Preston, column 9, lines 35-36. In fact, “the user 23 pushes button 206” after “the audio channel is established with another endpoint.” *Id.* at 36-38. Then “[a]fter the data has been successfully transmitted, the user presses button 206 again” to “reconnect switch 204 to the audio receiver 17.” *Id.* at 42-44. At best, Preston discloses, ~~at this point~~, a manual method of sending geographic location data from a wireless telephone mobile unit. For at least these reasons, claim 44 is patentable over Preston. Because claims 45-46 incorporate each of claim 44’s respective limitations they are patentable over Preston for at least the reasons discussed *supra*. Accordingly, Applicant respectfully traverses and requests reconsideration and withdrawal of the rejection.

#### ***Claim Rejections – 35 U.S.C. §103(a)***

Lastly, the Office action rejected claims 10, 29, 33, 36-43 and 47-51 as being unpatentable over Preston in view of U.S. Patent No. 6,677,894 (Sheynblat) under 35 U.S.C. § 103(a). These grounds for rejection should be withdrawn pursuant to 35 U.S.C. § 103(c) because the subject matter developed by another person, namely Preston et al., which

qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102, shall not preclude patentability under Section 103 where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. Such is the case here; both the Preston '121 patent and the present application were owned by Airbiquity Inc. at the time the invention was made.<sup>5</sup> The Preston patent assignment to Airbiquity Inc. F/K/A Integrated Data Communications, Inc. is recorded at 011575/0733. The present application was assigned to Airbiquity Inc. as well and recorded at 012880/0113.

Moreover, even if the Preston patent were available for an obviousness rejection, the rejection is not well-founded because Sheynblat does not remedy the deficiency of Preston discussed *supra*; claims 1, 27, 31, and 44 remain patentable over Preston even when combined with Sheynblat. Claim 10 depends from claim 1, claim 29 depends from claim 27, claims 33, 36-43 depend from claim 31, and claims 47-51 depend from claim 44. Claims 10, 29, 33, 36-43 and 47-51 are patentable over Preston in view of Sheynblat because each of the dependent claims incorporate the limitations of the independent claims. Accordingly, Applicant respectfully traverses and requests reconsideration and withdrawal of the rejection.

#### ***Claim Amendments***

Claims 30 is currently amended to remove a typographical error. Claims 1, 7-13, 27, 29-32, 34, 39, 43-45, 49, and 51 are currently amended for clarification.

#### ***New Claims***

New claims 52-58 are submitted for examination. These claims are believed to be patentable over the art of record for at least the following reasons. Claim 52 claims a “remote method of determining a geographic location of a wireless telephone mobile unit without intervention by a user of the mobile unit, the method comprising the steps of: at the mobile unit, receiving a location query via the wireless telecommunications network serving the mobile unit . . .” This is contrary to Preston, which indicates that “[t]he user 23 can push the button 206 anytime after manually calling up a phone number.” Preston, column 9, lines 35-36. Then “[a]fter the data has been successfully transmitted, the user presses button 206 again” to “reconnect switch 204 to the audio receiver 17.” *Id.* at 42-44.

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<sup>5</sup> Regarding the Preston '121 patent, a corresponding PCT application was published under publication number WO 01/72067 on 27 September 2001, less than a year before the present application was filed.

In addition, these claims are patentable over Patent Application No. 2002/006808 (Souissi) because "Souissi discloses a software-configurable RF modem for wireless data communications. The modem must be connected to a host computer which downloads software to configure the modem to implement various data communications protocols ('stacks') as needed. See Abstract, paragraph 10, and Figures 2A and 4. Souissi is directed to wireless data communications only; not voice. It does not disclose use in connection with a wireless telecommunications handset ('cell phone')." Quoting Response to Office Action mailed August 5, 2004, dated January 5, 2005.

### ***Conclusion***

In view of the foregoing, Applicant submits that all claims are in condition for allowance. Therefore, entry of the offered amendments and early issuance of the Notice of Allowance is respectfully requested. The Examiner is welcome to call the undersigned to discuss any aspect of this application. My direct-dial number (normal hours *Pacific Time*) is: 503-294-9189.

The Commission is hereby authorized to charge shortages or credit overpayments to Deposit Account No. 19-4455.

Respectfully submitted,

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### **Amendments to the Drawings**

The attached Three Replacement Sheets of drawings include substitute drawings of Figs. 1-3, respectively. These sheets replace original drawing sheets 1-3. No marked-up copy is included because no significant changes are made to the drawings. Rather, these new drawings are merely to improve the quality of lines, neatness of lettering, and the like.